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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,320	05/29/2001	Michael R. Schramm		6154

7590 12/04/2002

Michael R Schramm
350 West 2000 South
Perry, UT 84302

[REDACTED]

DOUGLAS, STEVEN O

ART UNIT	PAPER NUMBER
3751	

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/867,320	SCHRAMM, MICHAEL R.
	Examiner	Art Unit
	Steven O. Douglas	3751

-- The MAILING DATE of this communication appars on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 29 May 2001.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 and 25-35 is/are pending in the application.

4a) Of the above claim(s) 32-35 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-20 and 25-31 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 .	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Response to Amendment

Applicant is respectfully asked to resubmit the amendment filed 2-4-02 since there are obscured vertical black lines through the claims. Furthermore, it is respectfully requested to provide the correct application number on any papers filed with respect to this application (i.e. Applicant used the wrong application number when the filing the former amendment). However, an action on the merits is as follows.

Election/Restrictions

Applicant's election of Group I. in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). However it is noted that Applicant has added new claims 32-35 that are drawn to the non-elected subject matter. Accordingly, a restriction to one of the following inventions is required under 35 U.S.C. 121 still exists:

- I. Claims 1-20 and 25-31, drawn to a bubble creation apparatus, classified in class 141, subclass 098.000.
- II. Claims 32-35, drawn to a container, classified in class 141, subclass 098.000.

The inventions are distinct, each from the other because of the following reasons:

Inventions I. and II. are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant

case, the combination as claimed does not require the particulars of the subcombination as claimed such as the particulars drawn to a *non-cylindrical/non-conical funnel*. The subcombination has separate utility such as use in a combined device not requiring a bubble creation device (e.g. a spittoon or a dropper-type container).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

It is again noted that Applicant has elected Group I. and it will be Group I. that will be examined and the new claims 32-35 will be withdrawn from further consideration by Examiner. Furthermore, it is brought to Applicant's attention that Examiner requiring Applicant to elect an embodiment for examination was in error and that Examiner should have held Applicant to the Grouping of claims corresponding to the patented claims. For this, Examiner respectfully apologizes and an action on the merits on Group I. will be as follows.

Reissue Applications

The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The Oath/Declaration fails to identify the *citizenship* of the inventor. *See 35 USC 115 and 37 CFR 1.63(a)(3)*.

The Oath/Declaration fails to state that the inventor is a *sole* inventor of the claimed invention. *See 37 CFR 1.63(a)(4).*

The Oath/Declaration fails to state specifically how the new claims 25-31 differ from the patented claims and how they relate to the error set forth in the Oath/Declaration. *See 37 CFR 1.175(a)(1).*

The Oath/Declaration fails to include a statement *the "all errors being corrected in the reissue application up to the time of filing of the oath or declaration arose without and deceptive intention on the part of the applicant". See 37 CFR 1.175(a)(2).*

and 25-31
Claims 1-7₁ are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Particularly in amended claim 1, the omission of "said bubble producing device and said liquid emitting device are adapted to be selectively operated either together or independently of

each other" corresponds to subject matter applicant surrendered during the prosecution of the apparent application (i.e. Applicant added this limitation in paper #7 in the parent application to overcome a rejection of record). Furthermore, claims 25-31 do not contain any limitations from the original claims that were put in to make them allowable, therefore, claims 25-31 are accordingly rejected over recapture.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven O. Douglas whose telephone number is 703-308-0891. The examiner can normally be reached on Wed-Fri 6:30-7:00.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.


Steven O. Douglas
Primary Examiner
Art Unit 3751

SD
November 26, 2002